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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/813,153 | 03/30/2004 | Jean-Pierre Leblanc | SPG6601US1 | 5423 |

27624 7590 01/05/2009
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| EXAMINER |
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VENKAT, JYOTHSNA A

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| ART UNIT | PAPER NUMBER |
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1619

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| MAIL DATE | DELIVERY MODE |
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01/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|---------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/813,153 | Applicant(s) LEBLANC ET AL. | |
| | Examiner JYOTHSNA A. VENKAT | Art Unit 1619 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 20 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 20 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt is acknowledged of amendment and remarks filed on 10/10/08. Claims 18-19 and 22 have been canceled as per applicants' amendment dated 10/10/08. Claims 17, 20 and 23-28 are pending in the application.

The following new ground of rejection is necessitated by the amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 does not further limit the scope of claim since claim 17 recites the solubilized polymer in Markush group and claim 20 recites "poly (meth) acrylate", which includes polyacrylate and also polymethacrylate. Additionally claim 20 lacks antecedent basis since claim 17 recites "second solubilized polymer" and not second polymer.

Claim Rejections - 35 USC § 103

1. Claims 17, 20, and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,010,686 ('686) and 5,626,840 ('840) and 6,264,933 ('933).

Instant application is claiming a method of treating skin comprising:

1. Neutralized, solubilized anionic polyurethane

2. Solvent

3. Second polymer (polymethacrylate is the species, claims 18-20)

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The specification defines "solubilized urethane" as urethane being soluble in solvent.

Patent '686 teaches cosmetic composition using a polymeric system, which contains one film-forming polymer and use of this composition on the skin. See the abstract, see col.1, ll 1-16.

Patent '686 at col.2, ll 10-26 teaches:

10 The composition according to the invention makes it possible to obtain a homogeneous film which has a light texture and remains comfortable to wear all day long. The film is not at all sticky, while being soft, supple, elastic and flexible on the skin; it follows the movements of the support
15 on which it is applied without cracking and/or lifting off. It adheres completely to the lips. The composition according to the invention therefore is particularly advantageous as a composition for application to the lips, especially as lip rouge. The composition according to the invention also is
20 particularly advantageous as a composition for application as an eyeliner.

25 Furthermore, the film obtained in accordance with the present invention can be very glossy or more or less matte, depending on the nature of the particular constituents of the composition. This results in a wider range of make-up products which can be made glossy or matte at will.

Patent at col.2, ll 35-40 teaches various polyurethanes and this includes anionic polyurethane. Patent at col.4, ll 10-24 teaches:

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- 10 In the present description "dispersion of film-forming polymer" is intended to mean a dispersion capable of forming a film, including or not including a coalescing agent.
- 15 The solids content of the aqueous dispersions according to the present invention may range from 5 to 60% by weight, and preferably range from 30 to 40% by weight.
- The composition of the invention may include from 1 to 60% by weight, preferably from 5 to 40% by weight, of dry solids of film-forming polymers.
- 20 The particle size of the polymers in aqueous dispersion may range from 10 to 500 nm and preferably ranges from 20 to 150 nm, which makes it possible to obtain a film which has a remarkable gloss.

Patent at col.4, ll 40-45 teaches plasticizing agent and this includes water soluble solvents and water insoluble solvents. Patent at col.4, ll 50-62 teaches various glycol derivatives. Patent at col.5, ll 22-30 suggests adding additives like acrylic polymer into the compositions. See examples and see claim 2 for anionic polyurethane. Patent does not teach neutralized polyurethane.

Patent '840 teaches claimed anionic solubilized neutralized polyurethanes. Patent '840 teaches anionic polyurethanes which can be soluble or dispersible in water. See the abstract, and see col.2, ll 16-19 for the weight percent. Patent at col.5, lines 52-63 teaches:

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Neutralization renders the polymers soluble or dispersible in water for easy formulation into aqueous hair sprays (and thus contributes to removability). The neutralized polymers can be formulated solely in water as the solvent, or the solvent system can be a blend of polar organic solvent and water. Typically, the organic solvent will be an alcohol or ketone. Particularly suitable solvents are low boiling alcohols that are compatible with other components in the hair fixative composition, for example, C_1 - C_4 straight or branched chain alcohols. Exemplary polar solvents are ethanol, propanol, isopropanol, butanol, acetone, dimethyl-ether and dimethoxymethane.

The difference between these patents and the instant application is they do not teach second polymer. However patent '933 teaches film forming polymer and this includes anionic polyurethane as the film forming polymer. See col.2, line 34 and see col.4, ll 5-8 for the weight percent of the polymer. Patent '933 teaches various solvents at col.4, ll 17-25. Patent at col.4, ll 30-050 teaches additional film forming polymer can be added into the compositions and this includes polyacrylates and polymethacrylates claimed in the instant application.

Accordingly it would be obvious to one of ordinary skill in the cosmetic art to prepare compositions of patent '686 and substitute the anionic film-forming polymer with another functionally equivalent film forming polymer, which is neutralized solubilized anionic polyurethane of patent '840 and add additional film forming polymer (polyacrylate or polymethacrylate) taught by patent '933 in analogous cosmetic compositions. One of ordinary skill in the cosmetic art would modify the compositions of patent '686 by using neutralized and solubilized anionic polyurethane since these anionic polyurethanes are soluble in water for easy formulations. This is a prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 10/10/08 have been fully considered but they are not persuasive.

Applicants' argue:

“De la Poterie ('686) is directed towards cosmetic compositions for application to skin, wherein the composition includes an aqueous dispersion of film-forming polymer particles (Abstract). Useful film-forming polymers include synthetic polymers of the polycondensate or radical type, polymers of natural origin, and mixtures thereof (col. 2, lines 30-39). De la Poterie does not teach or suggest neutralized or solubilized polyurethanes. Further, de la Poterie does not teach or suggest the second polymer of the present composition (compositions comprising only the polyurethane are exemplified). Finally, de la Poterie does not teach methods for treating skin for moisturizing, firming and/or UV protection with compositions as presently claimed.

Thomaides is directed towards polyurethanes with carboxylate functionality for use as hair fixatives (e.g., hairsprays) (Abstract). The polyurethane of Thomaides is soluble or dispersible in water, is prepared from an organic diisocyanate, a diol, and a 2,2-hydroxymethyl-substituted carboxylic acid, and is neutralized with a cosmetically acceptable organic or inorganic base and formulated into a hair fixative composition containing low amounts of volatile organic solvent (Abstract). Thomaides does not teach the use of its polyurethanes in skin care compositions: As noted by the Examiner, Thomaides, like de la Poterie, does not

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teach or suggest the second polymer. Therefore, the combination of Thomaidēs and de la Poterie still is lacking in (1) the disclosure of the second polymer and (2) methods for treating skin for moisturizing, firming and/or UV protection with compositions as presently claimed.

Bodelin teaches cosmetic compositions for keratin fibers (hair - mascara for eyelashes; col. 2, lines 1-12) formed from at least one lamellar filler and an aqueous phase disperser). The aqueous phase contains a polymer system comprising at least one film-forming polymer dispersed in the aqueous phase in the form of solid particles (Abstract; col. 1, lines 55-63; col. 2, lines 18-21). Like de la Poterie, the film-forming of Bodelin is chosen from polycondensates (e.g., anionic polyurethanes; col. 2, lines 34-35), radical-generated polymers, and polymers of natural origin (col. 2, lines 22-25). Bodelin teaches that its compositions can also include an additional water-soluble film-forming polymer such as polyacrylates and polymethacrylates (col. 4, lines 30-49). Still, Bodelin does not teach or suggest methods for treating skin for moisturizing, firming and/or UV protection with compositions as presently claimed “.

In response to the above argument, patent ‘686 teaches anionic polyurethane in cosmetic compositions and teaches using cosmetic compositions for make-up, lip rouge, foundation and eyeliner and also teaches sun compositions and also dermatological compositions. Patent ‘686 does not teach claimed neutralized anionic polyurethane but patent ‘840 teaches claimed neutralized anionic polyurethane, therefore one of ordinary skill in the art would substitute anionic polyurethane in compositions of ‘686 with another functional equivalent anionic

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polyurethane, which is solubilized and neutralized anionic polyurethane of '840 expecting that the compositions can be applied over skin in the form of color cosmetics like make-up, lip rouge, foundation and eyeliner and sun compositions like sunscreens or suntan compositions or after-sun compositions. Patent '686 teaches dermatological compositions and one of ordinary skill in the art would prepare dermatological compositions in the form of moisturizers, creams, lotions and cleaning compositions since these formulations are conventionally applied to skin. This knowledge is available to one of ordinary skill in the art. Patent '686 at col.5, line 24 suggests adding another synthetic polymer like acrylic polymer. This is claimed in the instant application as second solubilized polymer consisting of acrylate. Patent '9333 teaches combination of film former like anionic polyurethane and also auxiliary film former which can be water soluble or water-insoluble at col.3, ll 35-45 and at col.4, ll 48-49 teaches polyacrylate and polymethacrylate as auxiliary film forming agents. Therefore, one of ordinary skill in the cosmetic art would be motivated to prepare compositions of patent '686 and substitute the anionic polyurethane film-forming polymer with another functionally equivalent film forming polymer, which is neutralized solubilized anionic polyurethane of patent '840 and add additional film forming polymer (polyacrylate or polymethacrylate) taught by patent '933 in analogous cosmetic compositions and use the compositions for color cosmetics and sun compositions and dermatological compositions.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619